

The opinion in support of the decision being entered today
was **not** written for publication in
and is **not** binding precedent of the Board.

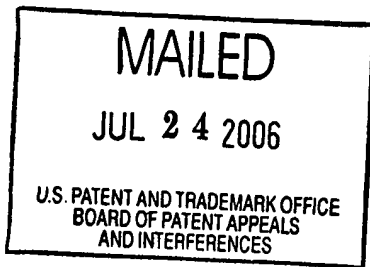
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. MAY

Appeal No. 2006-1776
Application No. 10/075,976

ON BRIEF



Before CRAWFORD, LEVY, and FETTING, **Administrative Patent Judges**.
FETTING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 1, 2, 3, 5, 6, 7, 8, 23 and 24. Claim 4 has been cancelled and claims 9 through 22 and 25 have been withdrawn from consideration after a restriction requirement, although they have not been cancelled.

We **REVERSE** and **MAKE A NEW GROUND OF REJECTION** UNDER 37 CFR § 41.50(b)

BACKGROUND

The appellant's invention relates to a method of producing personalized package wrapping. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of producing a personalized package wrapper that comprises at least one user submitted image, the method comprising the steps of:

displaying the user submitted image in a display area of an imaging device;

providing a window on said image to produce a windowed image, said window being movable relative to the image, and said windowed image comprising at least a portion of the image;

displaying a package wrapper image that includes a representation of at least a portion of a package wrapper which includes the windowed image thereon;

selecting a package wrapper size; and

performing at least one of a printing of the package wrapper with the windowed image thereon, a transmitting of the package wrapper image, and a storing the package wrapper image.

PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hinton	5,923,407	July 13, 1999
Jennel	6,102,536	August 15, 2000

We also make the following art of record

Acker et al. (Acker)	6,883,140	April 19, 2005 (filed February 24, 2000)
----------------------	-----------	---

Lively	U.S. Applic. Pub. No. 2002/090240	July 11, 2002 (eff. filing March 9, 2000)
--------	-----------------------------------	--

REJECTIONS

Claims 1, 2, 3, 5, 6, 7, 8, 23 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Jennel in view of Hinton.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejection, we make reference to the examiner's answer (mailed September 22, 2005) for the reasoning in support of the rejection, and to appellant's brief (filed August 12, 2005) and reply brief (filed November 25, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations that follow.

Claims 1, 2, 3, 5, 6, 7, 8, 23 and 24 rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Jennel in view of Hinton.

The appellant argues that the reference to Jennel does not disclose that a user submit an image to produce a windowed image nor the window being movable relative to the image or a portion of a package wrapper that includes an image thereon is shown on the display of the system [See Brief at p. 4], and that Hinton fails to show either as well [See Brief at p. 5].

The examiner responds that the appellant is not positively claiming displaying the package wrapper along with the windowed image on the display means; appellant is only using the word "displaying" which does not require the display means, or that alternatively, the background of Jennel's display means 22 could be considered as the image of the package [See Answer at p. 5]. As to Hinton, the examiner argues that Hinton discloses windowed image Fig. 2., via image 24 is movable relative to the image, via by customer's choice of the use of border 21; customers can select from a variety of different borders 21 to match with their image 24, in that case the process of choosing the best border and checking out if it match with the image, could be considered as moving the windowed image 24 relative to the image via respect to the selected border 21. [See Answer at p. 6]

The appellant then responds to the examiner's first argument that claim 1 and 8 refer to displaying a package wrapper image, and therefore simply printing the selected image on a package wrapper does not meet this limitation [See Reply Brief at p. 2], and that the background in Jennel does not represent the package wrapper [See Reply Brief at p. 4]. The appellant's response to the examiner's argument relating to Jennel

and Hinton and the movable window is that Jennel fails to discuss any structure providing windowing [See Reply Brief at p. 4] and that the selection of borders in Hinton only shows selecting size, not moving, Hinton's borders relative to the displayed image [See Reply Brief at p. 6].

As to whether Jennel displays a package wrapper image, we note that both independent claims are more broad than argued by the appellant in that they only require that at least a portion of a package wrapper is displayed and that the representation includes the windowed image thereon. Therefore, any image of a portion of the selected image that is imposed on the package wrapper would meet this limitation, because the image is itself part of the package wrapper of which only a portion must be displayed. None of the claims require that a portion of the wrapper excluding the selected image must be displayed. Either of the images in Jennel or Hinton would meet this requirement.

The limitation of a window movable relative to the image is not met by either reference however. As the appellant argued, we similarly are unable to find any reference to a movable window in Jennel and the examiner has not pointed to any. Similarly, the borders in Hinton are not movable relative to the selected image. Therefore, the examiner's argument that the claim 1 limitation of

providing a window on said image to produce a windowed image, said window being movable relative to the image, and said windowed image comprising at least a portion of the image;

and the comparable limitation in claim 8 is not persuasive.

Accordingly, we **do not sustain** the examiner's rejection of claims 1, 2, 3, 5, 6, 7, 8, 23 and 24 as rejected under 35 U.S.C. § 103 as being unpatentable as obvious over Jennel in view of Hinton.

New Grounds of Rejection Under 37 CFR § 41.50(b)

Pursuant to 37 CFR § 41.50(b), we enter the following new grounds of rejection:

Independent claims 1 and 8 are rejected under 35 U.S.C. § 103 as unpatentable as obvious over Lively in view of Acker.

Lively and Acker show:

A method of producing a personalized package wrapper [See Lively col. 2 para. 26 - gift-wrapping paper] that comprises at least one user submitted image [See Lively para. 53 – user could scan in the desired graphical image] , the method comprising the steps of:

displaying the user submitted image in a display area of an imaging device [See Lively para. 55 – the up-loaded graphical images 56 can be included in the custom-created design; also Fig. 9 image ref nbr 56];

providing a window on said image to produce a windowed image, said window being movable relative to the image, and said windowed image comprising at least a portion of the image [See Acker col. 7 line 66 to col. 8 line 15 describing an image crop window and Fig. 5 showing the shapes of such windows - the user at 133 selects a crop shape from the table, and the selected shape is superimposed over the image at 135 so that the user can **move and/or resize the image within the shape**] ;

displaying a package wrapper image that includes a representation of at least a portion of a package wrapper which includes the windowed image thereon; [See Lively para. 44 - Once the Internet user has selected all of the desired graphical image options 56 (**background, text, icons and overall layout of text and icons**), the web site 20 push a web page 28e to the screen 32 that **displays the entire custom-created design** 150 (step 540)]

selecting a package wrapper size; and [See Lively para. 50 - under the printable media type parameter, the following sub-parameters can be included: printable media type, selected color of the media (paper color)

and the file name for the media format information stored within the database that is associated with the selected media type. As an example, the actual media format information could include the size of block, number of repeated blocks, **size of the media** and other format information]

performing at least one of a printing of the package wrapper with the windowed image thereon, a transmitting of the package wrapper image, and a storing the package wrapper image. [See Lively para. 56 - to produce a final print image **for printing** on one of the associated printers 70 at the printing facility 240]

It would have been obvious to one of ordinary skill in the art to have applied Acker's image editing tool to Lively's custom gift wrapping device because of Lively's explicit recitation of using graphical image software applications [See Lively para. 27], of which Acker is an embodiment, and Acker's explicit recitation of the benefits of editing on a group of still images [See Acker col. 1 lines 6-10], of which Lively's catalog is an embodiment.

Accordingly, we **reject** the two independent claims 1 and 8 under 35 U.S.C. § 103 as unpatentable as obvious over Lively in view of Acker. We leave the consideration of the applicability of these references to the remaining claims to the examiner.

CONCLUSION

To summarize,

- The rejection of claims 1, 2, 3, 5, 6, 7, 8, 23 and 24 under 35 U.S.C. § 103 as being unpatentable as obvious over Jennel in view of Hinton, is **not sustained**.
- New grounds of rejection of independent claims 1 and 8 under 35 U.S.C. § 103 as unpatentable as obvious over Lively in view of Acker are made under 37 CFR § 41.50(b)

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50 (b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

REVERSED AND NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(b)



MURRIEL E. CRAWFORD
Administrative Patent Judge



STUART S. LEVY
Administrative Patent Judge



ANTON W. FETTING
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

AWF/lg

Appeal No. 2006-1776
Application No. 10/075,976

Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201